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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,364	01/12/2001	Jurgen M. Lehmann	018781000411	1585
20350	7590	08/24/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				MURPHY, JOSEPH F
ART UNIT		PAPER NUMBER		
1646				

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/760,364	LEHMANN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Joseph F Murphy	1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 June 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 and 33-41 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9, 33-41 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ .   | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

### ***Formal Matters***

Claims 1-9, 33-41 are under consideration.

### ***Response to Amendment***

The rejection of claims 1 -9 and 33-41 under 35 U.S.C. 1 12, first paragraphs because the specification, while being enabling for methods of identifying agents that affect hypercholesterolemia does not reasonably provide enablement for identifying agents that affect CAR-related diseases that involve aberrant cholesterol levels, has been obviated by Applicant's amendment and is thus withdrawn.

The rejection of claims 1 -9 and 33-41 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, has been obviated by Applicant's amendment and is thus withdrawn.

The rejection of claims 1 -9 and 33-41 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for recitation of the term "aberrant cholesterol levels", has been obviated by Applicant's amendment and is thus withdrawn.

New issues are set forth below.

***Claim Rejections - 35 USC § 112 first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-41 are rejected under 35 USC 112 first paragraph because the specification, while being enabling for methods of identifying agents that affect hypercholesterolemia by administration of the test compound to a transgenic non-human mammal having a genome with a disrupted CAR allele, does not reasonably provide enablement for methods of identifying agents that affect hypercholesterolemia by administration of the test compound to a CAR compromised mammal. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue.

In the instant case, the claims are directed to methods of identifying agents that affect hypercholesterolemia by administration of the test compound to a CAR compromised mammal, without defining a CAR compromised mammal, while the Specification only provides the example of methods using transgenic mice having a genome with a disrupted CAR allele.

Applicant has provided little or no guidance to enable one of ordinary skill in the art to determine, without undue experimentation, how to identify a CAR compromised mammal other than a transgenic non-human mammal having a genome with a disrupted CAR allele.

Due to the large quantity of experimentation necessary to generate the infinite number of derivatives and allelic modifications recited in the claims and possibly screen same for activity, the lack of direction/guidance presented in the specification regarding which structural features are required in order to provide activity, the absence of working examples directed to same, the complex nature of the invention, the state of the prior art which establishes the unpredictability of the effects of mutation on protein structure and function, and the breadth of the claims which fail to recite any structural or functional limitations, undue experimentation would be required of the skilled artisan to make and/or use the claimed invention in its full scope.

Given the breadth of claims 33-41 in light of the predictability of the art as determined by the number of working examples, the level of skill of the artisan, and the guidance provided in the instant specification and the prior art of record, it would require undue experimentation for one of ordinary skill in the art to practice the claimed invention.

***Claim Rejections - 35 USC § 112 second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 33-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite in the recitation of the phrase “cholesterol indicator is modulated”. In order for the agent to be therapeutic, it would need to lower the cholesterol levels in the test mammal, which the term “modulated” encompasses both increases and decreases in the levels. Claims 2-9 are rejected insofar as they depend on the recitation of the phrase “cholesterol indicator is modulated” in claim 1.

Claim 33 is vague and indefinite in the recitation of the term “CAR compromised mammal”. The term "CAR compromised mammal" in claim 33 is a relative term which renders the claim indefinite. The term "CAR compromised mammal" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the metes and bounds of the invention. Claims 34-41 are rejected insofar as they depend on the recitation of the term "CAR compromised mammal".

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The claims are drawn to methods of identifying a therapeutic agent by administration to a mammal after the agent has been identified in a screening method wherein the agent is screened to determine whether the agent can modulate a CAR-mediated molecular interaction. This method as written omits method steps because the method does not set forth the steps in the screening step. The method does not set forth the molecules for which their interaction is to be measured, nor does it set forth how this interaction is to be measured, and there is no control step wherein the interaction is compared to a control.

***Conclusion***

No claim is allowed.

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Murphy whose telephone number is (571) 272-0877. The examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
August 17, 2004



JOSEPH MURPHY  
PATENT EXAMINER